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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,402	10/22/2000	John Thaddeus Pienkos		9105
7590 PATENTBANK L.L.C. ATTN: John T. Pienkos 5017 N. HOLLYWOOD Ave. WHITEFISH BAY, WI 53217			EXAMINER	
			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/694,402	PIENKOS, JOHN THADDEUS	
	Examiner Carolyn M. Bleck	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 October 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 and 20-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is response to the amendment filed on 22 October 2006.

Claims 1-14 and 20-25 are pending. Claims 1-2, 7, 11-13, 14, and 20 have been amended. Claims 15-19 have been cancelled. Claims 21-25 are newly added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has added claims 21-22. Claim 21 includes a limitation of "making a preliminary determination based upon the customer information as to whether it is possible to provide the customer insurance of a first type with respect to the customer-owned item." Claim 22 recites "wherein (e) through (h) are repeated on multiple occasions in order to repeatedly obtain the insurance of the first type during multiple time periods determined by the time limitation and subsequent received time limitations." Applicant has not adequately described these claimed

limitations in the specification has originally filed in such a way as to reasonably convey to one skilled in the art that Applicant had possession of the claimed invention at the time the application was filed. The Examiner respectfully submits that Applicant provide support within the specification for these newly added limitations.

Claims 22-25 are dependent upon claim 21, and thus incorporate the deficiencies of claim 21 through dependency.

4. The rejections of claims 13 and 20 under 35 U.S.C. § 112, 2nd paragraph, are hereby withdrawn due to the amendment filed on 22 October 2006.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 9, 11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) in view of Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (mailed on 24 May 2006), and further in view of Cullen et al. (6,272,528).

(A) As per claim 1, Luchs discloses fully computerized insurance premium quote request and policy issuance method comprising:

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- (a) entering data into fields relating to a desired insurance coverage, wherein the fields include the effective date of the insurance policy, the expiration date of the insurance policy, and the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28), wherein the insurance is related to a dwelling, a homeowner (i.e., a house), an automobile, and watercraft (Fig. 10B, col. 7-8 see Table, col. 23 lines 3-15);
- (b) receiving at the central processor, which includes a databank, the information entered into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);
- (c) electronically and automatically comparing the data in the insurance application to certain underwriting criteria before actually proceeding with the printing of the insurance application, wherein the underwriting criteria compared with data include the effective date, expiration date, and city/ country code (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16 line 30 to col. 17 line 5);
- (d) sending the policy to printing if the policy does not need further approval based on the criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval (col. 16 lines 30-52).

Luchs includes the feature of receiving a customer specification setting time limits regarding a desired amount of insurance coverage (i.e., the effective date and the expiration date). However, Luchs does not include the feature of the time limit specifying a time period of less than a month. Felton discloses in his article that it is well known in the insurance arts to provide insurance to customers, wherein the insurance is limited to periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method of Luchs with the motivation of allowing a customer to reduce the high cost of insurance (Felton; page 1).

Claim 1 has been amended to include "as provided by way of a customer-operated terminal" and "to the customer operated terminal." Luchs and Felton do not expressly disclose the terminal being customer operated. However, Luchs clearly discloses a terminal. See Figure 1 and col. 3 lines 5-15.

Cullen discloses obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the insurance based on insurer-specific underwriting rules (reads on "confirmation"), to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance (col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and Felton with the motivation of allowing a customer to receive the most suitable quotation for insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

The remaining features of claim 1 are rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

(B) The amendments to claim 2 appear to have been made to merely correct minor grammatical errors (i.e., changing "the" to "a"), but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

(C) Claims 3-4, 6, and 9 have not been amended, and are therefore rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

(D) As per claim 5, Cullen discloses a computer operated by a customer for obtaining information about vehicle insurance policies (Fig. 1, col. 1 lines 10-19, col. 2 lines 1-11, col. 3 lines 1-21, col. 7 line 15-55). The remaining features of claim 5 are rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

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(E) As per claim 11, Luchs discloses a central processor of an insurance company (col. 3 lines 17-55), and providing the field and a confirmation as discussed in the rejection of claim 1 above. However, Luchs and Felton fail to expressly disclose the field and communication being provided "onto an internet communications link for receipt by a web client terminal that is the customer-operated terminal." Cullen discloses using the Internet to provide communications between a server and a customer computer (Fig. 1, col. 3 lines 1-21). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and Felton with the motivation of allowing customers to access information from many different sources over the Internet (Cullen; col. 1 lines 10-28).

(F) Claim 14 has been amended to include the limitations of "a customer-operated terminal," insurance "concerning an item owned by the customer." These amendments have been addressed above in the rejection of claim 1, and are incorporated herein. Claim 14 has also been amended to include the limitation of "if it is determined that the desired amount of insurance coverage can be provided, providing a notification to the customer-operated terminal indicating that the desired amount of insurance coverage can be provided." Luchs discloses (e) sending the policy to printing if the policy does not need further approval based on the criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval (col. 16 lines 30-52). Luchs does not disclose providing notification to the customer-operated terminal.

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Cullen discloses obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the insurance based on insurer-specific underwriting rules (reads on "notification"), to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance (col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and Felton with the motivation of allowing a customer to receive the most suitable quotation for insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

(G) As per claim 13, Luchs discloses allowing a user to input geographical information such as a zip code, state, or city (Fig. 10A-B), wherein the user input is received via telephone lines (col. 13 lines 59-63). The remaining features of claim 13 repeat limitations discussed in claims 1 and 14, and are therefore rejected for the same reasons, and incorporated herein.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial

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potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (24 May 2006), and Cullen et al. (6,272,528), as applied to claim 1 above, respectively, and in further view of Mizuno (6,380,953).

(A) The amendments to claim 7 appear to have been made to merely correct minor grammatical errors (i.e., changing "the" to "a"), but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (24 May 2006), and Cullen et al. (6,272,528), as applied to claim 1, and further in view of Pescitelli et al. (5,845,256).

(A) Claim 8 has not been amended, and is therefore rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

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9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (24 May 2006), and Cullen et al. (6,272,528), as applied to claim 1, and further in view of Applicant's admission of prior art.

(A) Claim 10 has not been amended, and is therefore rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

Furthermore, Applicant failed to traverse the use of Official Notice in the prior Office Action, and thus Applicant admits that claim 10 is well known in the prior art.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (24 May 2006), and Cullen et al. (6,272,528), as applied to claim 1, and further in view of Serdy (5,990,886).

(A) As per claim 12, Luchs discloses inputting a geographical region indication (Fig. 10D; col. 23 lines 15-28). The remaining features of claim 1 are rejected for the same reasons given in the previous Office Action (mailed 24 May 2006), and incorporated herein.

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11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526), Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11), for substantially the same reasons given in the previous Office Action (24 May 2006), and Cullen et al. (6,272,528), as applied to claim 14, and further in view of Insuremarket (note, previously referred to as Quicken) (Quicken website, Accessed from www.archive.org, dated 12/12/1998).

(B) As per claim 20, the teachings of Luchs, Felton, Cullen and the motivation for their combination are incorporated herein.

Luchs discloses a central processor of an insurance company (col. 3 lines 17-55).

Luchs and Felton do not expressly disclose providing web page information onto the internet for receipt by a client computer that is the customer-operated terminal, wherein the notification is provided onto the internet for receipt by the customer-operated terminal, and wherein the customer information is received off of the internet after being transmitted by the customer-operated terminal.

Cullen discloses obtaining details of a user's requirements for an insurance quotation via a user's computer, receiving by way of a mobile agent, the user's requirements for an insurance quotation at a server, and delivering the insurance quotation information, such as the types of insurance available and the price of the

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insurance based on insurer-specific underwriting rules (reads on "notification"), to the user at the user's computer, wherein the user's computer is operated by a customer wishing to purchase vehicle insurance, wherein information is provided to and from the customer's computer and the servers via the Internet (Fig. 1, col. 1 lines 10-18, col. 2 lines 1-11, col. 3 lines 1-21, col. 6 line 60 to col. 7 line 15, col. 7 line 15 to col. 8 line 32). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Cullen within the method taught collectively by Luchs and Felton with the motivation of allowing a customer to receive the most suitable quotation for insurance over the Internet (Cullen: col. 1 line 60 to col. 2 line 11).

Luchs, Felton, and Cullen does not expressly disclose the use of web pages.

Insuremarket discloses an insurance website for a customer to receive real-time quotes and purchase policies from the nation's leading insurance companies, wherein the customer enters information on a computer via a web browser over the Internet, wherein the Insuremarket system (reads on "insurance provider") receives information from multiple insurance companies and displays the quotes to a user (reads on "notification"), wherein upon the customer receiving the quotes, the customer is able to select the policy he or she would like and purchase the policy (see pages 1-8). As per the recitation of "a later time period," the Examiner notes that the Insuremarket discloses providing web pages over the Internet which would include an inherent delay to load web pages on a client computer.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Insuremarket within the method taught

collectively by Luchs, Felton, and Cullen with the motivation of providing a quick way to access insurance information using the Internet (pg. 2 of Insuremarket).

12. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over InsureMarket (Quicken website, Accessed from www.archive.org, dated 12/12/1998) in view of Luchs et al. (4,831,526) and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11).

(A) As per claim 21, Insuremarket discloses a method of providing insurance coverage from an insurer to a customer in relation to a home insurance and auto insurance (pages 4 and 6) comprising:

- (a) receiving an inquiry at a server computer hosting a website of the insurer (pages 1-2, 6) (It is noted that a user is able to submit information, such as a zip code, through Insuremarket's website to Insuremarket's server, which connects instantly to insurance companies);
- (b) providing an input for onto the internet to a first client computer operated by a customer (pages 1, 4-8);
- (c) receiving customer information at the server computer that has been input at the first client computer by way of the input form (pages 1, 4-8);
- (d) making a preliminary determination based upon the customer information as to whether it is possible to provide the customer insurance of a first type with respect to the customer-owned item (pages 6-7, It is noted that filling out a questionnaire of user

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requirements for a policy, providing a summary screen that will let user's compare policy options from several carriers, including the premiums, based on the questionnaire, and filling out an online application is a form of "making a preliminary determination"); and

(e) providing an indication to be received by the customer concerning whether the insurance of the first time can be provided with respect to the customer-owned item (pages 6-7, see the purchase screen allowing the user to purchase the insurance policy).

Insuremarket fails to expressly disclose (e) providing a field for inputting a time limitation relating to the insurance of the first type, the time limitation indicating a time period less than a month; (f) receiving the time limitation at the server computer; (g) performing processing in relation to the time limitation to determine whether the insurance of the first type as restricted by the time limitation can be provided with respect to the customer-owned item; and (h) providing an indication ... as restricted by the time limitation.

Luchs discloses:

(a) entering data into fields relating to a desired insurance coverage, wherein the fields include the effective date of the insurance policy, the expiration date of the insurance policy, and the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28), wherein the insurance is related to a dwelling, a homeowner (i.e., a house), an automobile, and watercraft (Fig. 10B, col. 7-8 see Table, col. 23 lines 3-15);

(b) receiving at the central processor, which includes a databank, the information entered into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(c) electronically and automatically comparing the data in the insurance application to certain underwriting criteria before actually proceeding with the printing of the insurance application, wherein the underwriting criteria compared with data include the effective date, expiration date, and city/ country code (col. 4 lines 26-47, col. 7 line 28 to col. 11 line 2, col. 16 line 30 to col. 17 line 5);

(d) sending the policy to printing if the policy does not need further approval based on the criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval, wherein the policy is limited to the effective date and expiration date (Fig. 10B, col. 16 lines 30-52) (It is noted that "providing an indication" is taught by InsureMarket, but Insuremarket does not clearly limit the policy based on a time limitation. This is taught by Luchs.)

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Luchs within the method of InsureMarket with the motivation of reducing the time and increasing the efficiency for a client to be underwritten and approved for an insurance policy (Luchs; col. 1 lines 36-62).

Luchs includes the feature of receiving a customer specification setting time limits regarding a desired amount of insurance coverage (i.e., the effective date and the expiration date). However, InsureMarket and Luchs does not include the feature of the time limit specifying a time period of less than a month. Felton discloses in his article that it is well known in the insurance arts to provide insurance to customers, wherein the insurance is limited to periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method taught collectively by InsureMarket and Luchs with the motivation of allowing a customer to reduce the high cost of insurance (Felton; page 1).

(B) As per claim 22, while Insuremarket, Luchs, and Felton do not *expressly* disclose repeating steps (e) through (h). However, it is noted that updating insurance information and purchasing insurance through Insuremarket (pages 6-7) is a form of repeatedly obtaining amounts of insurance. In addition, Luchs discloses that it is well known for a client to request supplemental coverage or want to add further risks to a policy or rider (col. 1 lines 50-62). It is respectfully submitted that repeating steps appears to be a form of duplication of "parts" (i.e., steps). The courts have broadly held that the duplication of parts is obvious. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). As such, these changes do not present a patentable distinction over the applied prior art of record.

(C) As per claim 23, Luchs discloses customer information including an identification number corresponding to a customer-owned vehicle with respect to which the customer desires to obtain insurance coverage (Fig. 11D, col. 25 lines 14-50). As per the recitation of "short-term insurance coverage," see the discussion of Felton in claim 21. As per the recitation of a web page in steps (b) and (h), note the discussion in claim 21 of web pages. As per the recitation of a web page in step (e), Insuremarket discloses

filling out an online application including limitations pertaining to the policy (pages 6-7, #4). As per the recitation of "time limitations," note the discussion of Luchs and Felton in claim 21.

(D) As per claim 24, Insuremarket discloses determining the cost of insurance of the first type as restricted by limitations (i.e., zip code (reads on "geographic limitation") and other limitations – see page 6, par. 4) (see also pages 6-7, premium payments). As per the recitation of a time limitation, see the discussion in claim 21 of Luchs and Felton.

As per the recitation of "selectable menu items," it is respectfully submitted that "selectable menu items" are well known in the computer programming arts. Selectable menu items, such as drop down menus, are commonly used in web pages. The motivation for modifying Insuremarket, Luchs, and Felton being to provide a user-friendly interface for a customer and to prevent the user from having to enter information.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over InsureMarket (Quicken website, Accessed from www.archive.org, dated 12/12/1998), Luchs et al. (4,831,526), and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11) as applied to claim 21, and further in view of Hartigan (US 2002/0022976).

(E) As per claim 25, Insuremarket discloses saving, accessing, reviewing, and updating insurance information by a customer at any time through a personal insurance portfolio. It is noted that updating insurance information and purchasing insurance through Insuremarket (pages 6-7) is a form of repeatedly ordering amounts of insurance. Insuremarket, Luchs, and Felton do not expressly disclose establishing an identifier by which the customer is able to log in to the website repeatedly at future time periods using the client computer, the identifier including at least one of a username and a password. Hartigan discloses entering policy information for a new insured and generating an access code and password for that insured; wherein the insured is able to enter information on insurance when logging in to the system (par. 12-13, par. 218-224, claim 1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Hartigan within the system taught collectively by Insuremarket, Luchs, and Felton with the motivation of allowing a user to determine whether they are eligible for insurance coverage (Hartigan; par. 10).

Response to Arguments

14. Applicant's arguments with respect to claims 1-14 (and cancelled claim 15) and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

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15. Applicant's arguments filed 22 October 2006 have been fully considered but they are not persuasive. Applicant's arguments are addressed below in the order in which they appear in the response filed on 22 October 2006.

(A) At pages 11-12 of the response filed 22 October 2006, Applicant argues that there is no suggestion to combine Luchs and Felton.

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Examiner has provided a motivation directly from the references themselves. See the motivations provided above in section 6(A).

In response to Applicant's argument that Felton does not suggest that short-term rental car insurance is only pertinent to rental cars and Luchs does not suggest that the method can be used for short-term insurance, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re*

Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In addition, in response to Applicant's argument that Luchs does not suggest that the method can be used for short-term insurance, the Examiner respectfully disagrees. Luchs provides a method for allowing a user to enter an effective date and an expiration date (Fig. 10B). This is a suggestion that the prior art is capable of allowing a user to enter a "short" time period. Based on this suggestion in Luchs, the Examiner has combined Felton with Luchs to teach Applicant's claimed invention. See section 6(A) above.

(B) At pages 12-14 of the response filed 22 October 2006, Applicant argues that the Norwich Union reference is evidence of nonobviousness of Applicant's claimed invention.

First, the Examiner recognizes that the Norwich Union is not prior art. The Norwich Union article was provided to Applicant simply to give Applicant an indication of the types of insurance products that are currently available.

Second, Applicant is arguing the commercial success of another party's product, namely Norwich Union. An Applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success. See MPEP § 716.03. The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention. See *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988). Applicant has failed to provide evidence establishing a nexus between

Applicant's claimed invention and evidence of its commercial success. Applicant has failed to show that the claimed features were responsible for the commercial success of the insurance product. See *In re Huang*, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996).

Third, it is noted that Applicant has failed to provide an affidavit under 37 C.F.R. 1.132. Any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section. See 37 C.F.R. 1.132. Affidavits or declarations, when timely presented, containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc., must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103. See MPEP § 716.01(a).

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

18. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

- (571) 273-8300 [Official communications]
(571) 273-8300 [After Final communications labeled "Box AF"]
(571) 273-6767 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

Carolyn Bleck
Carolyn M. Bleck
Patent Examiner
Art Unit 3626

12/21/06